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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,801	12/16/2003	Bert Klebl	DEAV2002/0089 US NP	4154
5487	7590	12/07/2006	EXAMINER	
ROSS J. OEHLER SANOFI-AVENTIS U.S. LLC 1041 ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			HAMA, JOANNE	
			ART UNIT	PAPER NUMBER
			1632	
DATE MAILED: 12/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/736,801

Applicant(s)

KLEBL ET AL.

Examiner

Joanne Hama, Ph.D.

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 16 November 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 112 1<sup>st</sup>, New Matter.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1, 3-15, 17, 18, 20 and 21.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Applicant filed a response to the Final Rejection of July 5, 2005 on November 16, 2006.

Claims submitted by Applicant November 16, 2006 have not been entered because the insertion of new limitations and deletion of a limitation focuses on an invention with different characteristics than that claimed April 5, 2006. As such, the claims of November 16, 2006 are not entered.

***Response to Arguments***

***35 U.S.C. § 112, 1<sup>st</sup> parag., New Matter***

Applicant's arguments, see page 5, filed November 16, 2006, with respect to the rejection of claims 1, 3-17, 20, 21 have been fully considered and are persuasive. Applicant indicates that with regard to the phrase, "wherein phenotyping is carried out by the reduction or elimination of compensating differential expression or by the labeling of at least one compensating differentially regulated gene," support can be found in originally filed claim 2. The rejection of claims 1, 3-17, 20, 21 has been withdrawn.

***35 U.S.C. § 112, 2<sup>nd</sup> parag.***

Applicant's arguments filed November 16, 2006, Applicant's response, page 5, have been fully considered but they are not persuasive. Applicant indicates that on page 6 of the Office Action (July 5, 2006), the Examiner indicates that the phrase, "wherein phenotyping is carried out by the reduction or elimination of compensatingly differential expression which is perceptible from the outside of said organism," (claim 1, step c) is contrary to the definition of "phenotype" cited in the American Heritage

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dictionary. Applicant indicates that definition of the claim falls within the definition cited by the dictionary. In response, this is not persuasive because the dictionary definition would indicate that the act of phenotyping would be to observe physical or biochemical characteristics of an organism (see, Office Action, page 5, definition 1.a.). Phenotyping would not be an act of reducing or eliminating compensating differential expression. Note that the specification indicates that the "phenotyping" is carried out following deletion, mutagenesis, or overexpression of the compensatingly regulated gene to enhance or generate a phenotype in combination with the heterologously expressed protein or protein fragment (specification, page 2, lines 19-36, in particular, lines 32-36). Perhaps to clarify the phrasing, the claim could be amended, "...wherein phenotyping is carried out following the reduction or elimination of compensating differential expression...". As such, the claims remain rejected.

**35 U.S.C. § 102**

Applicant's arguments filed November 16, 2006, Applicant's response, page 6, have been fully considered but they are not persuasive. Applicant's responses depend on the claim amendments of November 16, 2006. However, since the claims are not entered, the arguments as they relate to the amendments are moot.

**35 U.S.C. § 103**

Applicant's arguments filed November 16, 2006, Applicant's response, page 6-7, have been fully considered but they are not persuasive. Applicant's responses depend on the claim amendments of November 16, 2006. However, since the claims are not entered, the arguments as they relate to the amendments are moot.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Hama, Ph.D. whose telephone number is 571-272-2911. The examiner can normally be reached Monday through Thursday and alternate Fridays from 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras, can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

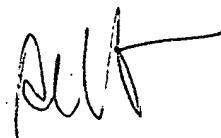
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JH

ANNE M. WEHBE' PH.D  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'A. Wehbe', with a horizontal line extending to the right.